

REMARKS

The Amendments

The method of use claims are amended so that they are directed to type II diabetes and obesity to address the 35 U.S.C. §112 rejection.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejections under 35 U.S.C. §112, second paragraph

The rejections under 35 U.S.C. §112, second paragraph, are believed to be rendered moot.

The rejection of claims 10 and 19-20 is rendered moot because the “arthritis” term is canceled from the claims.

The rejection of claim 8 is rendered moot because the “optionally” term was removed from the claim in the prior amendment.

Thus, the rejections should be withdrawn.

The First Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims 10, 16 and 19-20 under 35 U.S.C. §112, first paragraph, is rendered moot by the above amendments. The type II diabetes and arthritis recitations are removed from the claims. Thus, the rejection should be withdrawn.

The Second Rejection under 35 U.S.C. §112, first paragraph

The rejection of claims 1-3, 8, 10, 12 and 16-20 under 35 U.S.C. §112, first paragraph, is respectfully traversed.

The rejection appears to be made on the basis that there is lack of enablement of how to make the claimed compounds where R4 is a group XI-XIV or XXVII-XXX recited in the claims. The impetus for the rejection may be that the method of making claim 14 only pertains to making compounds where R4 is one of the other groups, not these. However, applicants urge that the disclosure of methods of making in the specification is not so limited as in the claims. The specification describes methods for preparing compounds of the formula (I) with any of the R4 groups as claimed at page 27, line 25, to page 34, line 7. Such methods describe alternatives wherein R4 is attached through a nitrogen atom or through a carbon atom, which covers all the possibilities for the R4 groups. Further, the specification indicates that such methods would be known to one of ordinary skill in the art. Additionally, at pages 38-45, the specification describes eight general types of examples for preparing the claimed compounds and indicates that such methods can be analogously applied to a number of other compounds of the claimed invention. Applicants submit that the examples provide a sufficient representation of the methods such that one of ordinary skill in the art could prepare all compounds within the claimed scope using only routine experimentation for their level of skill. In accordance with In re Marzocchi et al., 169 USPQ 367 (CCPA 1971) and MPEP §2164.04, the PTO has not provided reasons or evidence to doubt the truth or accuracy of the inventors' statements in the specification that the compounds can be made as described. The PTO has this burden to establish a case for non-enablement and applicants believe it has not been met here. Thus, it is urged that this rejection under 35 U.S.C. §112, first paragraph, be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this

response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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